

(D) REMARKS

The issue is whether the cited reference anticipates the present invention. A valid rejection on the ground of anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. Soundsciber Corp. v. U.S., 148 USPQ 298, 301 (1966); In re Donohue, 226 USPQ 619, 621 (Fed. Cir. 1985).

It is axiomatic that claims are not to be interpreted in a vacuum. Slimfold Mfg. Col v. Kinkead Indus., 810 f.2d 1113, 1 USPQ 2d 1563 (Fed. Cir. 1987); Moleculon Res. Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986). The claim and specification language must be considered. DMI, Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed. Cir. 1985). By ignoring the present application's use of the claims language and terms as discussed in the Detailed Description, the argument as set forth in the Action ignores this requirement. Understanding, or interpreting, a limitation already in a claim in light of the Detailed Description is not the same as an impermissible reading of a limitation into a claim. Otherwise, these court decisions are rendered meaningless.

It is clear from the Hayashi et al. reference itself that there is no disclosure of a "molecular colorant" as that term is unambiguously described by the present application of Vincent et al. and as is used in the claims. Hayashi et al. describe only a "...a sphere-like resin *body made of two semispheres* capable of being manufactured easily, and a *microcapsule containing electrophoretic particles...*" (see e.g., Abstract; emphases added). This same mechanism is described for all embodiments, including those referenced specifically by the Examiner. This is in the same manner as microspheric technology described by E-Ink Co. or Xerox Inc in their similar methods and apparatus already described by the present applicants Vincent et al. in the Background of the Invention section. This is a relatively "macro-technology" in comparison to the present invention's "nanotechnology." The way, means, and function of operation of microsphere based inks and dyes are entirely different. The

“particles” inside the microcapsules are not molecular switches. Hayashi et al. does not describe, disclose or even suggest nanotechnology molecular level mechanisms, only microcapsule mechanisms. There is no logical reading nor interpretation of Hayashi et al. which results in a disclosure of a “molecular colorant.” Therefore, Hayashi et al. fail to anticipate the present invention.

In contrast, Vincent et al. describe and define and claim molecular level switches wherein each molecule is a separate switch. In fact, the Appendix is devoted to a lengthy description of various embodiments of specific molecules. The patentee may be his own lexicographer. Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 228 U.S.P.Q. 20 (Fed. Cir. 1985); Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 219 U.S.P.Q. 1137 (Fed. Cir. 1983). “Molecular colorant” as used in the claims is clearly defined as employing the nanotechnology described in the Detailed Description and Appendix. The Vincent et al. specification (page 12, line 14 et seq.) states:

“...the molecule is switched into one state by the electric field and relaxes back into its original state upon removal of the field; such molecules are referred to as “bi-modal”. In effect, these forms of the bi-modal colorant molecules are “self-erasing”. In contrast, in bistable colorant molecules the colorant molecule remains latched in its state upon removal of the field (non-volatile switch), and the presence of the activation barrier in that case requires application of an opposite field to switch the molecule back to its previous state. Also, “molecular colorant” as used hereinafter as one term to describe aspects of the present invention is to be distinguished from other chemical formulations, such as dyes, which act on a molecular level; in other words, “molecular colorant” used hereinafter signifies that the colorant molecules as described in the Appendix and their equivalents are employed in accordance with the present invention.”

Further technical distinction is evident in that the Vincent et al. "molecular colorant" changes its inherent color from one color state to another in response to changes in an applied electric field. For example, spectral absorbency of the molecule may change from non-absorbing in the visible spectrum (visibly transparent) to fully absorbing in the visible spectrum (black appearing). On the other hand, the relatively macro-sized "particles" of each of the "semisphere" devices of Hayashi et al, E Ink and Xerox,, do not change their inherent color (there is no spectral change), but simply move in and out of view of the observer to give the "perception" of a color change. Clearly, microsphere (or "semisphere" as Hayashi et al. label them) type devices do not and can not anticipate the Vincent et al. invention.

It is respectfully requested that the rejection be withdrawn.

Questions or suggestions that will advance the case to allowance may be directed to Counsel by teleconference at the Examiner's convenience.

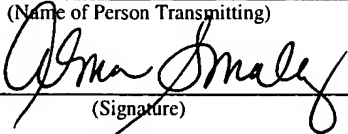
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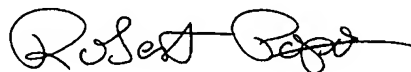


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